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December 6, 2007

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450


Re:   **Application No.:**                   09/991,748  
      **Confirmation No.:**               7030  
      **Art Unit:**                       3692 (Examiner Frantzy Poinvil)  
      **Appellants:**                   Enright, et al.  
      **Title:**                         Automated Banking Machine System and  
  Method  
      **Docket No.:**                   D-1112 R4

Sir:

Please find enclosed a Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer dated October 9, 2007 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this filing and any other fee due to Deposit Account 09-0428.

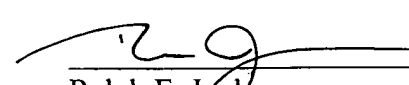
Very truly yours,

  
Ralph E. Jocke  
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D-1112 R4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants:	<b>Enright, et al.</b>	)	
		)	
Application No.:	<b>09/991,748</b>	)	Art Unit 3692
		)	
Confirmation No.:	<b>7030</b>	)	
		)	
Filed:	<b>November 23, 2001</b>	)	Patent Examiner
		)	Frantzy Poinvil
		)	
Title:	<b>Automated Banking Machine</b>	)	
	<b>System and Method</b>	)	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
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**REPLY BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 41.41**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. This Reply Brief is in response to the Examiner's Answer ("Answer"), dated October 9, 2007.

## **STATUS OF CLAIMS**

Claims 1-39 are pending in the Application.

The claims subject to appeal are 1-39.

Claims rejected: 1-39

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The questions presented in this appeal are:

- 1). Whether Claims 1-39 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Stinson, et al. (US 6,149,056) (hereafter "Stinson").

## **ARGUMENT**

### **Appellants' Reply to the "Grounds of Rejection" section of the Answer**

The rejections set forth in the Answer (at pages 3-5) appear to be identical to the grounds previously presented (at pages 4-7) in the final rejection of October 19, 2006, from which this appeal was taken. Thus, Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in Appellants' Appeal Brief of June 21, 2007. Therefore, please note Appellants' previous arguments (in their Appeal Brief) regarding all the issues of record. Appellants' Appeal Brief dated June 21, 2007 is herein incorporated by reference.

### **Appellants' Reply to the "Response to Argument" section of the Answer**

The Answer includes a "Response to Argument" section beginning on page 5. However, this section provides no new support for the rejections. Most of this section's "answer" consists of merely repeating allegations already presented in the "Grounds of Rejection" section of the Answer. Thus, Appellants respectfully submit that the Office's "answer" has already been fully addressed in their Appeal Brief. The Office still has not provided any factual support for the allegation of anticipation.

Furthermore, the "Response to Argument" section of the Answer only addresses a portion of the many arguments made in support of allowance in the Appeal Brief. The Answer's Comments appear to only be directed to Appeal Brief pages 15-19. Nor does the Office state which comments correspond to which claims. Thus, it follows that Appellants' reply remarks also may not be directed to specific claims.

The Answer does not treat each claim as a whole, but rather each claim feature is improperly considered in a vacuum. The Answer dissects individual segments from a claim and then alleges that the individual segment is taught. The Answer ignores the recited relationships among the many features. As a result, the Answer procedurally fails to establish a case of anticipation.

The Office's comments will now be addressed in the order they appear in the Answer. For reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

I. Appellants argued in their Appeal Brief at page 15 that "Stinson does not teach, mention, or need 'electronic signature'". In response, instead of acknowledging that Stinson does not teach the "electronic signature" feature, the Office (beginning at Answer page 5, last paragraph) follows a predictable path of attempting to redefine a claim term in order to allege anticipation. In this case the Office attempts to redefine a term well known to one of ordinary skill in the art, i.e., "electronic signature". That is, without any legal authority or technical support, the Office simply redefines an electronic signature as being "any operation of the user as being captured by a camera".

After redefining "electronic signature", the Office then predictably states that Stinson "clearly teaches capturing the image of the user at an ATM". The Office, based on its redefinition of a claim term, then concludes that "Thus, the captured image data of the user as done in the system of Stinson et al. is similar to the claimed "electronic signature".

Stinson does not anticipate the claims. Where is there any evidence in the record of "electronic signature" being defined as "any operation of the user as being captured by a camera", as alleged and relied upon by the Office? Nor would the Office's new definition of "electronic signature" be accepted as accurate by one of ordinary skill in the art. The acknowledged need by the Office to try to define a claim term in a manner that is not consistent with its ordinary and accepted meaning in the art, is evidence that the claims are not anticipated.

Furthermore, the Office's reliance on alleged "similarity" and "similar" (at Answer page 6, lines 7 and 12) is not a legal basis for a holding of anticipation. Rather, the acknowledged need by the Office to rely on something other than an exact "teaching" is further evidence that anticipation is absent. The allegations of "similarity" and "similar" at best smack of attempted "obviousness". Stinson does not anticipate the claims.

**II.** Appellants argued in their Appeal Brief at page 15 that "Stinson does not receive an agreement input (regarding electronic signature) from a user of the machine". Even the Office admits that Stinson does not teach "an agreement to capture the image of the user" (Answer at page 6, last paragraph).

In response, the Office again follows a predictable path with regard to a reference not specifically teaching a feature, i.e., allege inherency. In this case the Office simply alleges (at Answer pages 6-7) that the feature "is an inherent feature in the system of Stinson".

Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the applied reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in the applied reference. Inherency may not be established

based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

The Answer provides no factual support in the prior art for the allegation of inherency. Rather, the Answer provides (on Answer page 7) three mere speculations in an attempt to support the allegation of inherency (which speculations are the basis for the further allegation of anticipation). Nowhere does the Answer (including the three speculations) address receiving an input from a machine user, especially an input indicative of user agreement regarding an electronic signature. Nowhere does the Answer show where the alleged agreement inputted by a user is inherently taught in Stinson. The Office has not established anticipation by inherency.

Nor does Stinson inherently teach the recited feature. Structure that absolutely requires the carrying out of the recited method is not "necessarily present" in Stinson. There is no prior art evidence of record that Stinson's system, in its normal and usual operation, would necessarily perform the method claimed (e.g., claim 1). For example, where is Stinson's structure limited to only receive input from a user of the machine that is indicative that the user agrees that the user's electronic signature shall include data corresponding to an image of the user in the manner recited in claim 1 at step (b)? Rather, one skilled in the art would understand that Stinson's structure does *not* require receiving agreement input from a machine user in the manner recited in claim 1 at step (b). The Office has not established that the recited feature is mandatory or "necessarily present" in Stinson. Again, Stinson doesn't even mention "electronic signature".



Furthermore, evidence of record must teach the recited features. Assertions not based on evidence in the record, which is the current situation, lack substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Again, the Office has not established inherency or anticipation.

**III.** The Office had alleged (at final Action page 4, line 1) that Stinson uses an electronic signature "for purposes of signing the document". In response, Appellants argued in their Appeal Brief at page 16 that "if Stinson uses a customer's handwritten signature (as admitted by the Office), then why would Stinson need a user's 'agreement' to use electronic signature 'for purposes of signing the document'?" That is, Stinson's requirement for a handwritten signature *teaches away* from any need in Stinson for an electronic signature (and also any need for an electronic signature agreement input from a machine user).

In response, the Office (on Answer page 7, last paragraph) simply responds that "an electronic signature is not . . . an electronic signature generated by the computer", but "is an agreement to take an image of the customer". However, the Office's reasoning is illogical and finds no factual support in the evidence of record.

The Office (on Answer page 8, lines 1-3) further contends that "such a condition is an inherent feature in the system of Stinson et al because the customer is aware that an image of himself or herself will be taken and he/she must agree that such an action is performed". However, images of people are legally captured at business locations (like banks and ATMs) without any prior agreement from the person whose image is captured. Where does Stinson teach that his customers are so special that they first "must agree" to have their image taken before it can be captured, as alleged by the Office? Furthermore, where does Stinson teach that

this alleged agreement is via machine user input? Stinson has no such teaching. Nor can Stinson anticipate the claims.

**IV.** Appellants argued in their Appeal Brief at page 15 that "Stinson's requirement for a handwritten signature *teaches away* from any need for an electronic signature or any need for an electronic signature agreement from a machine user".

Again, the Office has failed to explain why Stinson would need a customer's inputted agreement to use an electronic signature when a handwritten signature is what is required and relied upon in Stinson. As Stinson requires a handwritten signature, there is no valid reason for Stinson to additionally require an electronic signature. Nor is use of plural signatures, especially both a handwritten signature *and* an electronic signature, taught in Stinson.

Again, the Office illogically contends (at Answer page 8) that "the capturing of the image of the customer is the electronic signature". Again, Stinson does not anticipate the claims.

**V.** Appellants argued (on Appeal Brief page 16) that even if it were somehow possible (which it isn't) for Stinson to teach, as the Office alleges, that "the user has/had agreed to authorization", such agreement still would not have been received via *input* "from a user of the machine".

The Office asserts (at Answer page 8) that Stinson teaches to "instruct a customer to remove his/her hat before capturing the image of that customer". However, it is unclear how this allegedly teaches receiving a user agreement via machine user input. Nor does it provide a teaching of what Appellants' claims recite. Again, Stinson does not anticipate the claims.

**VI.** Appellants argued (on Appeal Brief pages 18-19) with regard to the "through operation of the machine" feature (e.g., claim 1 at step c), that Stinson does not teach that the relied upon ATM (350) operates to acquire data corresponding to an image of the customer. The Office still

has not shown where Stinson teaches that the relied upon machine (ATM 350) controls or operates the camera (125) to capture an image. Where does Stinson teach that the camera (125) is part of the ATM (350), as apparently alleged by the Office? Note Figures 3A and 3B in Stinson with regard to separation of the camera (125) and the ATM (350). Additionally, Stinson (at col. 8, lines 1-6) lists the information that the ATM (350) sends to the processor (300). A captured user image is not a part of this sent information.

The Office avoids the issue regarding step (c) of claim 1 by simply contending that "the appellant is arguing issues not being claimed". However, the Appeal Brief addresses both the issues being claimed and the Office's arguments. Stinson does not anticipate the claims.

**VII.** Appellants argued in their Appeal Brief at page 19 with regard to claim 2 that "Stinson further does not teach applying indicia corresponding to a user image to a document". That is, Stinson does not teach applying indicia to a document, where the indicia corresponds to a user image. Also note claims 16, 20, and 28.

The Office asserts (at Answer page 9) that Stinson correlates a check with an image of a user. The Office does not explain how this assertion establishes that Stinson teaches applying indicia to a check, where the indicia corresponds to a user image. Nor can it. Appellants respectfully submit that the meanings of "applying" and "indicia" are well known to those of ordinary skill in the art, and that the Office misconstrues these meanings.

The Office (at Answer page 9) also indicates that applying indicia to a document "does not construe or imply printing" to a document. The Office's point is unclear as the Appeal Brief does not mention "print" or "printing". However, claim 28 is directed to a marking device operative to apply indicia to a document. The Office is silent as to where the recited "marking

device" can be found in Stinson. This is because Stinson does not teach applying indicia to a document, especially indicia that corresponds to a user image. Stinson does not anticipate the claims.

### **Other Issues**

Many points have been presented by Appellants in their Appeal Brief that the Office has not attempted to address. For example, the Office remains silent as to where Stinson allegedly teaches the feature of asking a machine user to agree to have an electronic signature include user image data. Note the Appeal Brief remarks regarding claims 26 and 35, and at page 15. Nor has the Office addressed Appellants' many arguments on pages 20-31 of the Appeal Brief.

The Office's failure to specifically address each recited claim feature, and inability to specifically point out the presence of each of Appellants' recited features in the Stinson reference, constitutes Agency Action under the Administrative Procedures Act admitting that the Stinson reference does not have the recited claim features. For these additional reasons Stinson does not anticipate the claims.

## CONCLUSION

Stinson neither explicitly nor inherently anticipates the claims. For sake of brevity and to avoid further repetition of the Appeal Brief, attention is again directed thereto for additional reasons as to why the Stinson reference does not anticipate any of the appealed claims. More detailed remarks regarding all the issues of record, including support for the patentability of each claim, can be found in the Appeal Brief.

Appellants respectfully submit that the claim rejections are not legally valid. Therefore, it is respectfully submitted that the holding by the Examiner should be reversed.

Respectfully submitted,



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